

**REMARKS**

Claims 35-66 and 73-100 are pending in the instant application.

**I. Petition Under 37 C.F.R. § 1.313(c)**

Applicants acknowledge and thank the Office for indicating that Applicants' Petition under 37 C.F.R. § 1.313(c) filed on October 15, 2004 was granted. Decision mailed October 26, 2004.

**II. Amendment under 37 C.F.R. § 1.312**

Applicants acknowledge and thank the Examiner for indicating that Applicants' amendment filed on April 22, 2004 under 37 C.F.R. § 1.312 has been entered. Response to Rule 312 Communication mailed December 7, 2004.

**III. Request for Continued Examination**

Applicants acknowledge and thank the Examiner for indicating that "[s]ince this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114." Office Action at page 2.

In addition, the Examiner notes that "the amended sequence listings and the petition for withdrawal from issue under 37 CFR 1.313(c)(2) filed 10/21/04 are acknowledged, entered and considered." *Id.*

#### IV. Response to New Matter Objection

Applicants' amendment filed October 21, 2004 has been objected to as allegedly introducing new matter into the disclosure.<sup>1</sup> Office Action at page 2. Applicants respectfully traverse.

Initially, Applicants acknowledge and thank the Examiner for the interview of January 4, 2005. Applicants' Interview Summary is filed concurrently herewith. In addition, as noted in the Interview Summary, during the interview, it was discovered that the Sequence Listing filed on July 30, 1999 and received by the Office on August 3, 1999 was not present in the Office's electronic files.<sup>2</sup> Applicants submit herewith a courtesy copy of the Sequence Listing mailed on July 30, 1999 with an OIPE stamped postcard dated August 3, 1999. The Sequence Listing mailed on July 30, 1999 provides that SEQ ID NO: 5 contains an Xaa at position 39, yet does not include a feature description that Xaa<sub>39</sub> is Proline, Homoproline, 3-hydroxyproline, 4-hydroxyproline, thioproline, N-alkylglycine, N-alkylpentylglycine, or N-alkylalanine. *See*, Sequence Listing filed July 30, 1999 at page 6, under "Variant" and "29."

In the Office Action mailed December 7, 2004, the Examiner acknowledges that "SEQ ID NO: 5 has been amended in the Sequence Listing filed 10/21/04 to delete the feature description of Xaa<sub>39</sub> as proline, homoproline, 3-hydroxyproline, 4-

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<sup>1</sup> The Examiner indicates that "[c]laims 35-66 and 74-100 are objected and would be allowable if the objection to specification and objection of SEQ ID NO: 5 in the Sequence Listing as new matter as set forth in [the] Office action are overcome." Office Action at page 3.

<sup>2</sup> The Office noted during the Interview that a Raw Sequence Listing Error Report dated August 16, 1999 showing errors to the Sequence Listing was present in the Office Records.

hydroxyproline, thioproline, N-alkylglycine, N-alkylpentylglycine or N-alkylalanine. However, on page 25, line 19 in the instant specification as originally filed recites that Xaa<sub>39</sub>-Z<sub>2</sub>. Z<sub>2</sub> is defined as -OH or -NH<sub>2</sub>....” Office Action at page 3. The Examiner alleges however that “[t]here is no definition for Xaa<sub>39</sub> in the instant specification as filed. Thus, SEQ ID NO: 5 as amended in the Sequence Listing provides definition for [sic] Xaa<sub>39</sub> that is not supported by the specification as originally filed.” *Id.* The Examiner concludes that “the specification is objected for not defining Xaa<sub>39</sub>, and the amended SEQ ID NO: 5 in the Sequence Listing is objected as New Matter by providing definition for Xaa<sub>39</sub> which was not supported by the specification as originally filed.” *Id.* Applicants disagree.

Initially, Applicants submit that amending the Sequence Listing to recite the same feature descriptions of SEQ ID NO: 5 as in the application as originally filed cannot be new matter. The Examiner argues that “the amended SEQ ID NO: 5 in the Sequence Listing is objected as New Matter by providing definition for Xaa<sub>39</sub> which was not supported by the specification as originally filed.” Office Action at page 3. As the Examiner acknowledges, the “specification as originally filed recites that Xaa<sub>39</sub>-Z<sub>2</sub>.” *Id.* As described previously, SEQ ID NO: 5 was amended to delete the Feature Description of Xaa<sub>39</sub> in the Sequence Listing that was not supported in the specification as originally filed. *See*, Amendment Filed in Conjunction with Request for Continued Examination filed October 21, 2004 at page 2 and Petition for Withdrawal from Issue Under 37 C.F.R.

§ 1.313(c) filed October 21, 2004.<sup>3</sup> Applicants have not added anything to SEQ ID NO: 5 in the Sequence Listing that was not contained in the specification as originally filed. Applicants simply deleted a feature description that was added during prosecution. Such a deletion cannot form the basis of a new matter rejection.

In addition, the Examiner objects to the specification because “[t]here is no definition for Xaa<sub>39</sub> in the instant specification as filed.” Office Action at page 3. Applicants disagree that Xaa<sub>39</sub> is not defined in the specification as filed. However, even assuming *arguendo* that Xaa<sub>39</sub> of SEQ ID NO: 5 is not defined in the specification as filed, the lack of a definition in a specification cannot be the basis for a new matter objection.

In light of all of the arguments above, it was agreed during the Interview on January 4, 2005 that the amendments to the Sequence Listing are supported by the specification as originally filed and do not constitute new matter, therefore the new matter objection should be withdrawn.

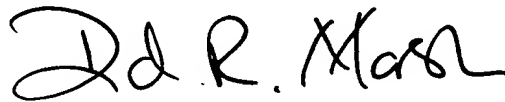
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<sup>3</sup> The feature description for Xaa<sub>39</sub> in SEQ ID NO: 5 deleted by the Amendment filed October 21, 2004 was added to SEQ ID NO: 5 in an amended Sequence Listing mailed January 21, 2000.

**Conclusion**

Applicant submits that the present application is now in condition for allowance, and notice of such is respectfully requested. The Examiner is encouraged to contact the undersigned should any additional information be necessary for allowance.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Dd R. Marsh". The signature is fluid and cursive, with the first two letters of the first name being prominent.

Thomas E. Holsten (Reg. No. 46,098)  
David R. Marsh (Reg. No. 41,408)

Date: January 6, 2005

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